

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 30,00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Metz Baking Company

Serial No. 75/058,375

Sana Hakim of Bell, Boyd & Lloyd for Metz Baking Company.

Christopher Wells, Acting Managing Attorney, Law Office
101.

Before Cissel, Chapman and Wendel, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On February 15, 1996, applicant filed the above-referenced application to register the mark "GRANDMA'S" on the Principal Register for "fruit cakes," in Class 30. The basis for filing the application was applicant's claim of use of the mark and use in interstate commerce since 1912.

The Examining Attorney refused registration under Section 2(d) of the Act on the ground that applicant's

mark, as applied to fruitcake, so resembles the marks "GRANDMA'S"¹ and the mark shown below,²



Both of which are registered for "cookies," that confusion is likely.

Applicant responded with argument that confusion is not likely. Applicant stated that the word "grandma" appears in the marks in over five hundred federal and state trademark applications and registrations, and that of those, over a hundred and sixty are for food items. Copies of six of the third-party registrations listing "cookies" or "cookie dough" as the goods were made of record with this argument: "GRANDMA BETH'S COOKIES" and design for cookies (Reg. No. 1,986,828); "GRANDMA MILLER'S COUNTRY BAKIN'" for, inter alia, cookies (Reg. No. 1,670,426);

¹ Reg. No. 1,119,007, issued on the Principal Register to Grandma's Foods, Inc. on May 22, 1979; combined affidavit filed under Sections 8 and 15; The registration claims use since 1914 and use in commerce since 1930. It was assigned to Recot, Inc. on September 15, 1989.

² Reg. No. 1,987,936, issued on the Principal Register to Recot, Inc. on July 23, 1996; The registration claims use and use in commerce since August 8, 1993.

"GRANDMA GEBHARD'S" and design for, inter alia, frozen cookie dough (Reg. No. 1,472,543); "Grandma Hills" for cookies (Reg. No. 1,466,483); "GRANDMA GOLDE" for, inter alia, cookies (Reg. No. 1,062,388); and "GRANDMA LEE'S" and design for, inter alia, cookie mix (Reg. No. 927,449).

Based on the third-party registrations, applicant argued that because there are so many "grandma's" marks in the food category, including those registered for cookies or cookie dough, it is not likely that consumers will confuse applicant's mark with the two cited marks.

Further, applicant argued that it had owned a registration for the mark "GRANDMA'S FRUIT CAKE" for fruit cake, Reg. No. 1,346,547, since it issued on July 2, 1985, and that it coexisted for seven years with Registration No. 1,119,007 (the cited registration for "GRANDMA'S") without any actual confusion.

The Examining Attorney was not persuaded by applicant's evidence or argument, and the refusal to register was made final with the second Office Action. Attached to that Office Action were copies of registrations from the Office records showing that several marks were registered for both cookies and fruitcake. The Examining Attorney argued that this evidence establishes that other companies market both products under their own trademarks,

and that because fruitcakes and cookies move through the same trade channels to the same ordinary consumers, confusion is likely when the mark "GRANDMA'S" is used on both.

Applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing before the Board.

The sole issue before the Board in this appeal is whether confusion is likely. We hold that it is.

The test for resolving this issue is well settled. We must first consider the similarity of the marks, in terms of their appearances, their pronunciations, their connotations and their overall commercial impressions. Then we must compare the goods set forth in the cited registrations with the goods as identified in the application to determine if they are related in such a way that the use of the marks in question is likely to lead to confusion or mistake in the marketplace for such products. In re E. I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Applicant's mark is identical to the first cited registered mark, "GRANDMA'S," and it creates a commercial impression that is very similar to that of the mark in the second cited registration by virtue of being the dominant

element thereof. The design element in that registered mark only amplifies or reinforces the word "GRANDMA'S." All three of these marks are very much alike. Plainly, their use on the same or closely related goods is likely to cause prospective purchasers to assume, mistakenly, that the source of all such products is the same.

Both fruitcakes and cookies are bakery goods which consumers have a reason to expect to come from the same source. As the third-party registration information made of record by the Examining Attorney shows, a number of different businesses have their marks registered for both fruitcakes and cookies. While not evidence of what actually happens in the marketplace, that the marks therein are in actual use, or that the public is familiar with the marks shown therein, third-party registrations are an acceptable way for the Examining Attorney to show that the goods listed therein are commercially related. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993). As noted by the Examining Attorney, these bakery products, both confections, move through the same channels of trade and are bought by ordinary consumers in the same kinds of stores.

As noted above, we conclude that confusion is likely when applicant's mark, identical to one of the cited marks

and very similar to the other, is used on these closely related products.

Applicant's argument is not well taken that its previous registration of the mark "GRANDMA'S FRUIT CAKE" and the third-party registrations applicant submitted of marks including the word "GRANDMA" as an element therein require registration of applicant's "GRANDMA'S" mark.

As we noted above, third-party registrations, while appropriate for helping demonstrate that consumers may have a basis to expect the goods listed therein to come from one source, are not evidence of the use of the marks therein or that the public is familiar with the use of such marks. In re National Aeronautics and Space Administration v. Record Chemical Co., 185 USPQ 563 (TTAB 1975). Third-party registrations, by themselves, are entitled to little weight in resolving the issue of whether the marks are similar. In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). In any event, the marks shown in the registrations submitted by applicant include matter which distinguishes them from each other and from applicant's mark. Each creates a commercial impression which is different from the other third-party marks, and from both applicant's mark and the two cited registered marks as well. Only applicant's mark and the two cited marks are essentially "GRANDMA'S" without

some other name or term. In summary on this point, the third-party registrations submitted by applicant are not persuasive evidence that confusion is unlikely.

Applicant's argument that its previous registration of "GRANDMA'S FRUIT CAKE" for fruitcake mandates registration to applicant of "GRANDMA'S" for fruitcake now is to no avail. Applicant argues that the period during which its claimed registration coexisted with the cited registration without applicant becoming aware of any actual confusion demonstrates that confusion is unlikely now.

We have no information on which to base such a conclusion. We do not have evidence showing that there was even an opportunity for actual confusion to have occurred, e.g., that the parties promoted or sold their goods under these marks at the same time to the same people in the same geographic region. Moreover, the question before us now is whether confusion is likely, not whether it has ever happened. That an applicant in an ex parte proceeding before the Board is unaware of actual confusion, either with its current mark, or with a mark it used to use and had registered for a time, is not persuasive of the proposition that confusion is unlikely. See *In re Energy Telecommunications and Electrical Assoc.*, 222 USPQ 350 (TTAB 1983).

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For the reasons set forth above, we hold that confusion is likely and affirm the refusal to register under Section 2(d) of the Act.

R. F. Cissel

B. A. Chapman

H. R. Wendel
Administrative Trademark Judges
Trademark Trial and Appeal Board

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